

## **REMARKS**

Claims 1 and 3-45 are pending in the present application. Claim 2 is currently canceled and claims 1, 11, 12, 22, 23, 27, and 35 are currently amended.

In the Office Action, the Examiner objected to claims 2, 10, 21, 24, 28, 37, and 45 as being dependent upon a rejected base claim. The Examiner rejected claims 36, 38, 39, 42, 43, and 44 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,899,995 issued to Millier et al. (hereinafter “Millier”). Additionally, the Examiner rejected claims 1, 3-9, 11-20, 22, 23, 25-27, 29-35, 40, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Millier. Each of these rejections is addressed in detail below.

### **Rejections Under 35 U.S.C. § 102**

The Applicant believes that the Examiner rejected claims 36, 38, 39, 42, 43, and 44 under 35 U.S.C. § 102(b) as being anticipated by Millier. Specifically, the Examiner stated, “Claims 36, 38, 39, 42, 43, and 44 are rejected under 35 U.S.C. § 102(b) as been anticipated by U.S. Patent 6,519,580 issued to David E. Johnson et al. (hereinafter ‘Johnson’).” However, based on the column and line citations in the Office Action, the Applicant believes this is a typographical error and thus presently addresses the Millier reference. The Applicant respectfully traverses the rejection under 35 U.S.C. § 102.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a

single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The Applicant directs the Examiner’s attention to independent claim 36, from which claims 38, 39, 42, 43, and 44 depend. Specifically, independent claim 36 recites, “using the degree of correspondence of at least one of the item features to invoke an additional categorizer.” The Millier reference does not teach this limitation. In the Office Action, the Examiner indicated that Millier disclosed this feature in column 4, lines 39-48. *See* Office Action, page 3. The entire text of this citation is set forth below:

#### Constraints and Profiles

As mentioned above, a SmartFolder is associated with a set of constraints or rules that govern what documents are eligible to be placed in that folder. These rules can refer to indirect attributes that are calculated by evaluating the feature set of the document against a user profile. This facility is implemented using the InfoEvaluator technology one embodiment of which is described in the U.S. Pat. No. 5,799,304 assigned to the same assignee of the present invention.

However, the Applicant stresses that this portion of Millier merely discloses information evaluation techniques. Millier does not disclose using a degree of correspondence to invoke an additional categorizer. In fact, Millier does not even teach an additional categorizer. Accordingly, the Applicant asserts that Millier does

not teach each and every limitation of the rejected claim. Therefore, the Applicant requests that the Examiner withdraw the rejection under 35 U.S.C. § 102.

In view of the deficiencies presented above, the Applicant asserts that independent claim 36 is in condition for allowance. Additionally, because claims 38-45 depend from claim 36 and for the unique features recited therein, the Applicant requests that the Examiner withdraw the rejection of these claims and place them in condition for allowance.

### **Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 1, 3-9, 11-20, 22, 23, 25-27, 29-35, 40, and 41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,899,995 issued to Marshall A. Millier et al. (hereinafter “Millier”). The Applicant respectfully traverses this rejection in view of the amendments and remarks set forth in the present paper.

In the Office Action, the Examiner stated that claims 2 and 10, *inter alia*, “would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Office Action, page 2. In accordance with the Examiner’s suggestion, Applicant amended independent claim 1, 12, 23, 27 and 35 to include limitations generally similar to the limitations of claim 2. The Applicant amended claims 11 and 22 to include limitations generally similar to the limitations claim 10. Accordingly, the Applicant asserts that the Examiner’s rejection under 35 U.S.C. § 103 is now moot. The Applicant is making these amendments to place the claims in condition for allowance, not because the Applicant concedes the correctness of the rejection. Moreover, the Applicant reserves the right to contest the rejection on the merits in a continuing application.

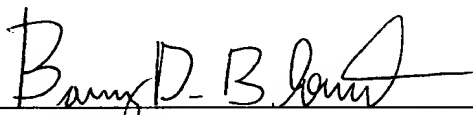
In view of the remarks and amendments set forth above, Applicant requests that the Examiner withdraw the rejection of claims 1, 3-9, 11-20, 22, 23, 25-27, 29-35, 40, and 41 under 35 U.S.C. § 103. The Applicant requests an indication of the allowability of claims 1, 11, 12, 22, 23 27, and 35, and the claims dependent thereon.

**Conclusion**

In view of the remarks set forth above, the Applicant respectfully requests allowance of claims 1 and 3-45. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Barry D. Blount  
Reg. No. 35,069  
(281) 970-4545

**HEWLETT-PACKARD COMPANY**  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400